



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/006,171 | 12/04/2001 | Jeremy Burr | 5038-138 | 2907 |

32231 7590 08/15/2005

MARGER JOHNSON & MCCOLLOM, P.C.
 210 SW MORRISON STREET, SUITE 400
 PORTLAND, OR 97204

| |
|----------|
| EXAMINER |
|----------|

TRAN, HENRY N

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2674

DATE MAILED: 08/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/006,171

Applicant(s)

BURR ET AL.

Examiner

Henry N. Tran

Art Unit

2674

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendment received April 28, 2005 have been thoroughly considered; and this Office action is in response thereto.

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

The new claim element and limitation: “a source loop solenoid having an axis substantially perpendicular to a planar surface of the base unit” recited in claim 1 has no clear support or antecedent basis in the specification. The term “axis”, “perpendicular”, and “planar surface” are not exist in the specification.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-8,10-12, 14, 18-20, 22-24 and 26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent Application Laid-Open No. P2001-15994A to Shimono in view of US Patent Application Publication 2002/0036621 to Liu et al. (Liu).

Shimono in view of Liu teaches all the claim elements and limitations as recited in paragraphs 5-26 of the prior Office action.

Liu further teaches that the source loop solenoid 34 is formed of one or more turns of wire about an axis that is centered of the perimeter of the planar surface of the base or assembly

Art Unit: 2674

33, see Fig. 1; paragraphs 30 and 32; that is read on the newly added claim element and limitation: “a source loop solenoid having an axis substantially perpendicular to a planar surface of the base unit” recited in claim 1.

Claims 1-8,10-12, 14, 18-20, 22-24 and 26 are therefore stand rejected

4. Claims 27-29 stand rejected under 35 U.S.C. 103(a) as being unpatentable over published UK Patent Application GB 2,314,470 to Tien in view of Liu as recited in paragraphs 27-30 of the prior Office action.

Liu further teaches that the source loop solenoid 34 is formed of one or more turns of wire about an axis that is centered of the perimeter of the planar surface of the base or assembly 33, see Fig. 1; paragraphs 30 and 32; that is read on the newly added claim element and limitation: “wherein, the magnetic source loop solenoid has an axis substantially perpendicular to a planar surface over which the computer mouse is moved” recited in claim 1.

Claims 27-29 are therefore stand rejected.

5. Claims 9, 13, 15, 21, and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shimono in view of Liu as applied to claims 1 and 14 above, and further in view of Tien as recited in paragraphs 31-34 of the prior Office action.

6. Claims 16 and 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shimono in view of Liu as applied to claim 14 above, and further in view of US Patent 4,754,268 to Mori as recited in paragraphs 35-36 of the prior Office action.

7. Claim 30 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Tien in view of Liu as applied to claim 28 above, and further in view of Shimono as recited in paragraphs 36 of the prior Office action.

Response to Arguments

8. Applicants' arguments provided in page 6 of the above-identified amendment have been fully considered but they are not persuasive. Applicants argue that applicants' claimed invention requires that the source loop solenoid has an axis substantially perpendicular to the planar surface of the base unit.; whereas, the prior art, the Liu's patent teaches a solenoid that has an axis that runs circumferentially around the periphery of a pad, and thus the axis is parallel to the planar surface of the pad, rather than perpendicular as claimed invention. The examiner respectfully disagree because Liu's solenoid 34 runs circumferentially around the periphery of the pad 33, it has an axis parallel to the planar surface of the pad, and an axis perpendicular with the planar surface (Liu says "an axis that is centered in the base or housing of the device" and "the antenna may comprise ...any sort of axis...", see Fig. 1; and paragraph [0032]).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

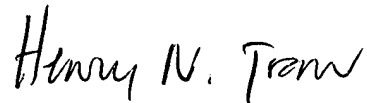
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 2674

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry N. Tran whose telephone number is 571-272-7760. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick N. Edouard can be reached on 571-272-7603. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry N Tran
Primary Examiner
Art Unit 2674

8/10/05